

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the comments that follow.

Claims 1-18 were pending in this application. In this response, claims 2-11 and 17 have been amended, claim 1 canceled, and claims 19-23 added. Thus, claims 2-23 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, page 4, lines 22-28 and 30-32, page 5, lines 21-26, page 9, line 12, page 20, lines 8-9 and Table 3.

CLAIM OBJECTIONS

Claim 1 was objected to because of informalities directed to the use of the European number convention. This claim is obviated by the cancellation of claim 1. Withdrawal is respectfully requested.

SPECIFICATION

Tables 1 and 2 of the Specification were objected to for using European convention for numbering, i.e., using a comma for the decimal place. Applicants have amended Tables 1 and 2 (and also Tables 3-4, which were observed to have the same numbering convention) to use English numbering, i.e., a decimal point for the decimal place. Reconsideration is requested.

DOUBLE PATENTING REJECTION

Claim 17 stand provisionally rejected on the grounds of being a substantial duplicate of claim 1 on the grounds set forth at page 2 of the Official Action. Claim 1 has been canceled. Accordingly, this rejection is now moot and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Application No. 2001-49399 (hereafter “JP-399”) on the grounds set forth at page 3 of the Official Action. The rejection is respectfully traversed.

The present specification teaches, for example, that in order to avoid determination in the hot working properties of the alloy, the copper content must be kept below 0.1 % by weight (see, page 5, lines 21-26). By the present amendment, the alloy composition now includes this feature.

In contrast, JP-399 discloses that Cu is added to the composition in an amount of 0.1 to 3.0 wt.% (see, Abstract and page 3 of the USPTO provided translation).

In view of the above, Applicants respectfully assert that a *prima facie* case of obviousness has not been established.

First, there is no overlap between the claims less than 0.1 wt-% Cu and the teaching in JP-399 of 0.1-3.0 wt-% Cu. Thus, the present rejection is missing an element of the claim and a *prima facie* case of obviousness has not been established.

Second, there is no basis for a modification to reduce the amount of Cu in JP-399 to include the amount claimed by Applicants. (see, *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. ___, (2007); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]jections on obviousness grounds

cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”); *see also, Aventis Pharma Deutschland GmbH V. Lupin Ltd.*, 499 F.3d 1293 (Fed. Cir. 2007) (finding it remained necessary to show “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). No such articulated reason is present nor is there one in view of the express teaching in JP-399 to have higher Cu content, i.e., up to 3 wt-%.

For at least the above noted reasons, the present rejections should be reconsidered and withdrawn.

NEW CLAIMS

New claims 19-23 have been added. Each of these claims depends from claim 17 and, therefore, distinguishes over JP-399 for at least the same reasons as discussed above. Further, claims 19-21 each include a specified amount or range of Co. No such element is included in the composition of JP-399. Thus, at least these claims further distinguish over the cited reference.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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Date: January 16, 2009

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